

## **REMARKS**

### **A. Objection to Specification**

In the Office Action mailed on May 28, 2004, the continuity statement at page one of the specification was objected to for failing to update the status of U.S. Patent Application Serial no. 10/141,392. In view of the present Amendment that has amended the continuity statement to make mention of U.S. Patent No. 6,735,879, the objection has been overcome and should be withdrawn.

### **B. Objection to Claims**

Claims 4, 22 and 48 were objected to for several informalities. In particular, claim 4 was objected to for using “plane” instead of “planar.” In view of the present Amendment wherein “plane” has been replaced by “planar,” the objection has been overcome and should be withdrawn.

Please note that amendment being made to claim 4 is being solely made to correct an obvious typographical error and so is not related to patentability as defined in *Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 234 F.3d 558, 56 USPQ2d 1865 (Fed. Cir. 2000) (*en banc*), *overruled in part*, 535 U.S. 722 (2002).

Claim 22 was objected to for failing to have proper antecedent basis for “the fan.” In view of the deletion of the phrase “and the fan substantially lies within a second planar surface that intersects the first plane surface at an angle” the objection has been overcome and should be withdrawn.

Please note that deletion of the phrase “and the fan substantially lies within a second planar surface that intersects the first plane surface at an angle” broadens the scope of claim 22 and so is not limiting to the scope of claim 22 per *Festo*.

Claim 48 was objected to for being repetitive of claim 47. In view of the cancellation of claim 47, the objection has been overcome and should be withdrawn.

Please note that cancellation of claim 47 is solely being made to correct an obvious typographical error and so is not related to patentability as defined in *Festo*.

**C. 35 U.S.C. § 102**

**1. Fiebig et al.**

Claims 46-49, 51, 52 and 54-56 were rejected under 35 U.S.C. § 102(b) as being anticipated by Fiebig et al. Applicants traverse this rejection. The present application is a continuation application of U.S. Patent Application Serial No. 10/141,392, which was filed on May 7, 2002. Fiebig et al. was granted on September 25, 2001, which is not more than one year prior to Applicants' effective filing date of May 7, 2002. Accordingly, the rejection under Section 102(b) is improper and the rejection should be withdrawn.

Despite the impropriety of the rejection, claim 46 has been amended to clarify that "the pin does not rotate during the movement from the first position to the second position." Assuming for arguments sake that Fiebig et al. qualifies as prior art, Fiebig et al. does not disclose a pin that does not rotate. Instead, Fiebig et al. discloses an adjusting screw 30 that is rotated via adjusting wheel 34 so that the screw 30 moves in or out of the leveling device 10 (Col. 2, ll. 49-58). Accordingly, claim 46 and its dependent claims are not anticipated by Fiebig et al. and so the rejection should be withdrawn.

Besides not being anticipated by Fiebig et al., claim 46 is not rendered obvious by Fiebig et al. because there is no suggestion or motivation to replace Fiebig et al.'s rotating screw mechanism with a non-rotating mechanism. Without such suggestion, claim 46 is patentable over Fiebig et al.

**2. Goodrich et al.**

Claims 61-66 were rejected under 35 U.S.C. § 102(b) as being anticipated by Goodrich et al. Claim 61 has been canceled rendering its rejection moot. Claims 62-64 and 66 have been amended so as that the remaining claims 62-66 depend directly or indirectly from claim 67, which has not been rejected based on the prior art. Accordingly, the rejection has been overcome and should be withdrawn.

Note that the amendments of claims 62-64 and 66 are being made to provide additional patent coverage for the method of claim 67 and so the amendments are not related to patentability as defined in *Festo*.

**3. Dong**

Claims 74-79 were rejected under 35 U.S.C. § 102(b) as being anticipated by Dong. Applicants traverse this rejection. Claim 74 recites “attaching the line generating device to a surface.” The Office Action has relied on the passage at Col. 1, lines 28-50 as disclosing the recited attaching. However, a review of the passage reveals no disclosure of attaching a line generating device to a surface. Accordingly, claim 74 is not anticipated by Dong and so the rejection is improper and should be withdrawn.

Assuming for arguments sake that Dong did disclose attaching a line generating device to a surface, Dong does not disclose or suggest that such attachment is achieved by “inserting a pin through a portion of the device so that the pin pierces the surface” as recited in claim 74, as amended. Without such disclosure or suggestion to use a pin in the manner recited in claim 74, claim 74 and its dependent claims are patentable over Dong.

**D. 35 U.S.C. § 103**

**1. Fiebig et al. and Dong**

Claims 1, 2, 4-10, 15, 17, 19-22, 25-29, 34, 36-39 and 50 were rejected under 35 U.S.C. § 103 as being obvious in view of Fiebig et al. and Dong. Claims 1, 22 and 46 have been amended to clarify that “the pin does not rotate during the movement from the first position to the second position.” As demonstrated above in Section C.1, Fiebig et al. discloses an adjusting screw 30 that is rotated via adjusting wheel 34 so that the screw 30 moves in or out of the leveling device 10. Since Dong does not suggest altering Fiebig et al.’s structure so that Fiebig et al.’s screw 30 does not rotate during its translational movement, claims 1, 22 and 46 and their dependent claims 2, 4-10, 15, 17, 19-21, 25-29, 34, 36-39 and 50 are patentable over Fiebig et al. and Dong.

**2. Fiebig et al. and Goodrich et al.**

Claims 1-3, 11-14, 22, 24, 30-33, 46, 48, 50 and 53 were rejected under 35 U.S.C. § 103 as being obvious in view of Fiebig et al. and Goodrich et al. Claims 1, 22 and 46 have been amended to clarify that “the pin does not rotate during the movement from the first position to the second position.” As demonstrated above in Section C.1, Fiebig et al. discloses an adjusting screw 30 that is rotated via adjusting wheel 34 so that the screw 30 moves in or out of the leveling device 10. Since Goodrich et al. does not suggest altering Fiebig et al.’s structure so that Fiebig et al.’s screw 30 does not rotate during its translational movement, claims 1, 22 and 46 are patentable over Fiebig et al. and Goodrich et al.

The rejection of claims 11 and 12 is traversed in that the Office Action has failed to provide any motivation for using the cited radius of curvature. The burden for the Examiner under Section 103 is to establish some motivation to use the cited radius of curvature in Fiebig et al.’s device. No such motivation has been provided. The mere recitation that the cited radius of

curvature has not been shown to be critical and so must be obvious is an improper attempt to place the burden on the Applicants to show that the invention is patentable. Since the Office Action has failed to provide any motivation to use the cited radius of curvature, a prima facie case of obviousness has not been shown and so the rejection is improper.

The rejection of claims 11, 12, 30 and 31 is traversed in that the Office Action has failed to provide any motivation for using the cited radius of curvature. The burden for the Examiner under Section 103 is to establish some motivation to use the cited radius of curvature in Fiebig et al.'s device. No such motivation has been provided. The mere recitation that the cited radius of curvature has not been shown to be critical and so must be obvious is an improper attempt to place the burden on the Applicants to show that the invention is patentable. Since the Office Action has failed to provide any motivation to use the cited radius of curvature, a prima facie case of obviousness has not been shown and so the rejection is improper.

The rejection of claims 14 and 33 is traversed in that the Office Action has failed to provide any motivation for focusing light in Fiebig et al.'s device in an ovate shape. The Office Action has asserted that Goodrich et al. discloses such focusing. However, a review of the portions of Goodrich et al. being relied on for the above assertion (Figs. 13-15 and Col. 3, lines 46-61) does not reveal the formation of any ovate shape. Since there is no disclosure or suggestion in Goodrich et al. to shape Fiebig et al.'s beam into an ovate shape, the rejection is improper and should be withdrawn.

### **3. Goodrich et al. and Underberg**

Claims 68-72 were rejected under 35 U.S.C. § 103 as being obvious in view of Goodrich et al. and Underberg. Claim 68 has been canceled rendering its rejection moot. Claims 69, 71 and 72 have been amended so that the remaining claims 69-72 depend directly or indirectly from

claim 73, which has not been rejected based on the prior art. Accordingly, the rejection has been overcome and should be withdrawn.

Note that the amendments of claims 69, 71 and 72 are being made to provide additional patent coverage for the method of claim 73 and so the amendments are not related to patentability as defined in *Festo*.

**E. Obviousness-Type Double Patenting**

Claims 1, 2, 4-10, 16-23, 25-29, 35-52 and 54-84 were rejected under the judicially created doctrine of obviousness-type double patenting as being obvious in view of claims 1-54 of U.S. Patent No. 6,735,879. Applicants traverse the rejection to the extent that the rejection is premature in that there is the possibility that the claims will need to be amended to respond to various objections and rejections based on the prior art. In the present Amendment, a number of the claims have been amended for example. The appropriate time to address the rejection is when all of the claims have been deemed allowable, but for the obviousness-type double patenting rejections. Accordingly, Applicants will defer commenting on this issue until all of the claims have been deemed patentable.

On a related matter, it is noted that claims 16, 18, 23, 35, 40-45, 57-60, 67, 73 and 80-84 have not been rejected based on the prior art and so should be allowable once the obviousness-type double patenting issues have been resolved.

**F. New Claims 85-94**

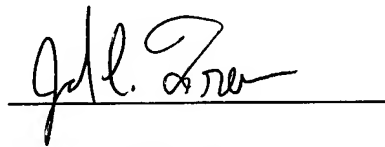
Claims 85-94 depend directly or indirectly from claims 1 and 22, and so are patentable for at least the same reasons given above in Section D.

Claims 85-94 are being presented to provide additional coverage for the devices of claims 1 and 22 and so they are not being presented for reasons of patentability as defined in *Festo*.

### CONCLUSION

In view of the arguments above, Applicants respectfully submit that all of the pending claims 1-46, 48-60, 62-67 and 69-94 are in condition for allowance and seeks an early allowance thereof. If for any reason, the Examiner is unable to allow the application in the next Office Action and believes that an interview would be helpful to resolve any remaining issues, she is respectfully requested to contact the undersigned attorneys at (312) 321-4200.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "John C. Freeman", is written over a horizontal line.

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